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Chuan Li  
7908 Avenida Navidad, #158  
San Diego, CA 92122  
Tel: (858) 361-7231  
Fax: (858) 558-1883  
Email: eti@znet.com  
September 10, 2003

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**Request for reconsideration of petition for expungement of  
unintentionally submitted information**

I appealed for expungement of unintentionally submitted information in the patent application earlier this year. Unfortunately the petition is **dismissed, subject to favorable reconsideration** as discussed in the decision letter from USPTO. A copy of the decision letter from USPTO and a copy of original petition are enclosed with this request.

Here I request for reconsideration of petition for expungement of unintentionally submitted information. This information is in paragraphs 3, 4, 5, and 6 in Example 2 of the patent application (starting with "Two oligos RNRPN1 and XNRPC1" and ending with "(Novagen, Madison, WI)") and the entire sequence listing which is generated from these paragraphs. A new paragraph should be added to the end of paragraph 2 in Example 2. The purpose of this addition is to make the patent application intact and complete after the expungement. To comply with 37 CFR 1.121 and 37 CFR 1.125, a substitute specification that does not contain paragraphs 3, 4, 5, and 6 in Example 2, and does contain the proposed new paragraph is presented. In addition, a "marked-up" copy of the

specification showing the additions and deletions is submitted. The substitute specification and the marked-up copy also comply with the amended rules effective July 30, 2003 to the best of the petitioner's knowledge.

The petitioner states that the substitute specification includes no new matter. The expunged information is trade secret and proprietary information for the patent assignee Expression Technologies Incorporated and that the information has not been otherwise made public by the applicant and assignee. Failure to obtain its return would cause irreparable harm to the applicant and the patent assignee. There is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted. This information is not part of the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§1.63 and 1.175. Expungement of the information will not affect whether to allow the application (i.e. the information is not material to the patentability), since entire Example 2 may be substituted with commercial recombinant proteins.



Chuan Li

Applicant name: Chuan Li

Title of the application: Protein standard for estimating size and mass

File Reference: ETI.PSEMS.011502

Application number: 10/068,663

Filing Date: 02/06/2002

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#8

Commissioner for Patents

USPTO

Washington, DC 20231

Chuan Li

7908 Avenida Navidad, #158

San Diego, CA 92122



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January 6, 2003

### **Petition for expungement of unintentionally submitted information**

I appeal for expungement of unintentionally submitted information in the patent application. This information is in paragraphs 3, 4, 5, and 6 in Example 2 of the patent application (starting with "Two oligos RNRPN1 and XNRPC1" and ending with "(Novagen, Madison, WI)") and the entire sequence listing which is generated from these paragraphs. This information is trade secret and proprietary information for the patent assignee Expression Technologies Incorporated and that the information has not been otherwise made public by the applicant and assignee. Failure to obtain its return would cause irreparable harm to the applicant and the patent assignee. There is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted. This information is not part of the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§1.63 and 1.175. Expungement of the information will not affect whether to allow the application (i.e. the information is not material to the patentability), since entire Example 2 may be substituted with commercial recombinant proteins.

The petition fee of \$130 set forth in 37 CFR 1.17 (h) is included (ETI check #1262).

Should the petition be granted, the end of the paragraph 2 of Example 2 should be changed from "were produced and purified as following:" to "were cloned by exonuclease III mediated cloning (Li et al., Nucleic Acid Res. 25:4165-4166, 1997) when applicable. They were produced and purified according to standard molecular biology protocols (J. Sambrook et al., Molecular cloning: A Laboratory Manual, Cold Spring Harbor Laboratory, Cold Spring Harbor, N. Y., 1989, Coligan et al., Current Protocols in Protein Science, Current Protocols, U. S. A., 1995, and Ausubel et al., Current protocols in Molecular Biology, Current protocols, U. S. A. 1994)." The purpose of this change is to make the patent application intact and complete after the expungement.

Should the petition be dismissed, I request this information be treated as trade secrete and proprietary information, be opened only by examiner or other authorized USPTO employee, and not to be published with the patent application.



Chuan Li

Applicant name: Chuan Li

Title of the application: Protein standard for estimating size and mass

File Reference: ETI.PSEMS.011502

Application number: 10/068,663

Filing Date: 02/06/2002

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Paper No. 9

Chuan Li  
Apt 158  
7908 Avenida Navidad Apt 158  
San Diego CA 92122

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AUG 18 2003

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In re Application of  
Li.  
Application No. 10/068,663  
Filed: February 6, 2002  
For: PROTEIN STANDARD FOR  
ESTIMATING SIZE AND MASS

DECISION DISMISSING PETITION

This is a decision on the petition submitted by facsimile transmission on August 27, 2002, requesting under 37 CFR 1.183 suspension of the requirements of 37 CFR 1.59(a) such that originally filed paragraphs 3, 4, 5, and 6 in Example 2 be expunged from this file.

The petition is **dismissed, subject to favorable reconsideration as discussed in more detail below**. Any request for reconsideration must be filed within TWO MONTHS of this decision. See 37 CFR 1.181(f). Extensions of time under 37 CFR 1.136(a) or (b) are not available.

Petitioner seeks expungement of unintentionally submitted trade secret information appearing in paragraphs 3, 4, 5, and 6 appearing in Example 2 of the instant specification, and insertion of a new paragraph.

Unfortunately the petition cannot be granted as petitioner did not comply with 37 CFR 1.121 and 37 CFR 1.125 which pertain to the manner of deleting and adding information to the specification. Petitioner should further note that these rules were amended effective July 30, 2003. In essence, petitioner will be required, as a condition of a favorable decision on the petition, to present a substitute specification that does not contain paragraphs 3, 4, 5, and 6 in Example 2, and does contain the proposed new paragraph. In addition, petitioner must also supply a "marked-up" copy of the specification showing the additions and deletions. The marked up and originally filed specification will be removed from this file. For petitioner's convenience, a copy of the rule change appearing in the Federal Register is enclosed. If petitioner is unable to prepare an amended and "marked-up" copies of the specification, he may wish to obtain the services of a registered practitioner, as the USPTO cannot prepare the amendment on behalf of petitioner. The USPTO cannot aid petitioner in selecting a registered practitioner. A list of practitioners registered to practice before the USPTO is available on the USPTO web site: [www.uspto.gov](http://www.uspto.gov).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

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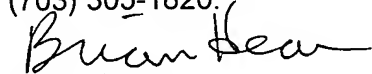
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By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 South Clark Place  
Arlington, VA 22202

Telephone inquiries relevant to this decision only should be directed to the undersigned at  
(703) 305-1820.



Brian Hearn  
Senior Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

Enclosure: 68 Federal Register 38611-38630 (June 30, 2003)